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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,669	12/23/1999	KELAN C. SILVESTER	42390.P8085	6426

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EXAMINER

VU, TRISHA U

ART UNIT	PAPER NUMBER
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2112

19

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/470,669

Applicant(s)

SILVESTER, KELAN C.

Examiner

Trisha U. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6-20-03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

1. Claims 1-5, 7-12, and 14-20 are presented for examination.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites the limitation "the base computer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7-9, 12, 14, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pipes (5,999,997) in view of Flanagan et al (6,128,661) (herein after Flanagan).

As to claim 1, Pipes discloses an electrical device comprising a housing to have the device docked into a notebook computer (col. 1, lines 7-8 and 48-50) having a memory to store a first operating system (first operating system) (col. 1, lines 26-36), an interface disposed on a surface of the housing to enable communication between the

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device and the notebook computer when the device is docked (Figs. 2A and 2B); a memory to store a second operating system (second operating system) (col. 1, lines 26-36); and a central processing unit CPU (second processing unit) to operate as a system processor of the docking computer when the device is undocked and to operate as a system CPU of the device when the device is undocked (col. 2, lines 4-6 and col. 5, lines 52-60). However, Pipes does not explicitly disclose the electronic device being a PDA and the second operating system is smaller in size and provides less functionality than the first operating system. Flanagan teaches a PDA with an operating system (e.g. Windows CE) smaller in size and provides less functionality than the operating system of the host computer (e.g. Windows 95, Windows NT, etc...) (col. 6, lines 42-51 and col. 7, lines 23-38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a PDA with an operating system smaller in size and provides less functionality than the operating system of the host computer as taught by Flanagan in the system of Pipes to provide a more compact and portable system.

As to claims 2 and 4, Pipes further discloses an input controller and an output controller to receive and output data when the device is undocked (col. 1, lines 38-40 wherein the device includes I/O devices, e.g. keyboard, monitor, or mouse, implies that there are I/O controllers).

As to claim 3, Pipes further discloses core memory to store input data when the device is undocked (at least memory 208) (Fig. 2B).

As to claim 5, Pipes further discloses a visual display coupled to the input/output controller (monitor 231). Pipes fails to disclose that the visual display being coupled to

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the input/output controller is via pen-based. Official notice is taken by examiner that pen-based interface is well known in the art for using with portable computer to provide input/output data.

As to claims 7-9, Pipes further discloses a battery to provide power to the CPU when the device is undocked, the battery is recharged when docked, and the computer provides power to the processor when docked (note col. 3, lines 52-57).

As to claim 12, Pipes discloses a notebook computer (first computer-100) comprising a docking port to receive a computer device (second computer-200) (Figs. 2A and 2B, and col. 1 lines 7-8) having a CPU to operate as a system CPU of the notebook computer when the device is docked, and to operate as a system CPU of the computer device when undocked (col. 2, lines 4-6 and col. 5, lines 52-60), the computer device including a memory to store a first operating system (second operating system) (col. 1, lines 26-36); an interface in the docking port to enable communication between the computer device and the notebook computer when the computer device is docked (Fig. 2A and 2B); and a memory to store a second operating system (first operating system) (col. 1, lines 26-36). However, Pipes fails to disclose that the computer device is a hand-held computer and the second operating system of the notebook computer is larger in size and has greater functionality than the first operating system of the hand-held computer. Flanagan teaches a hand-held computer with an operating system (e.g. Windows CE) smaller in size and provides less functionality than the operating system of the host computer (e.g. Windows 95, Windows NT, etc...) (col. 6, lines 42-51 and col. 7, lines 23-38). It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to implement a hand-held computer with an operating system smaller in size and provides less functionality than the operating system of the host computer as taught by Flanagan in the system of Pipes to provide a more compact and portable system.

As to claim 14, Pipes further discloses the interface is to couple a power supply of the notebook computer to a battery in the core computer to charge the battery and to provide power to the CPU when the core computer is docked (Fig. 2B and col. 3, lines 52-57).

As to claim 17, Pipes teaches a method of operating a computer system comprising: operating a CPU as a system CPU of a notebook computer when a core computer is docked in a docking port of the notebook computer, and operating the CPU as a system processor of the core computer when the core computer is undocked (col. 2, lines 4-6 and col. 5, lines 52-60), the notebook computer including a memory to store a first operating system (first operating system); and the core computer including a memory to store a second operating system (second operating system) (col. 1, lines 26-36).

However, Pipes does not explicitly disclose the second operating system is smaller in size and provides less functionality than the first operating system. Flanagan teaches a PDA with an operating system (e.g. Windows CE) smaller in size and provides less functionality than the operating system of the host computer (e.g. Windows 95, Windows NT, etc...) (col. 6, lines 42-51 and col. 7, lines 23-38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a PDA with an operating system smaller in size and provides less functionality than the

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operating system of the host computer as taught by Flanagin in the system of Pipes to provide a more compact and portable system.

As to claim 18, Pipes does not explicitly disclose synchronizing memory of the notebook computer with memory of the core computer when the core computer is docked. Flanagin further discloses synchronizing memory of the notebook computer (memory 8) with memory of a docked device (memory 6) (col. 13, lines 31-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to including synchronizing memory of the notebook computer with memory of a docked device as taught by Flanagin in the system of Pipes to so that data can be updated to the latest version.

As to claim 19, Pipes further discloses charging a battery in the core computer when the core computer is docked (note col. 3, lines 52-57).

4. Claims 10, 11, 15, and 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pipes (5,999,997) in view of Flanagin et al (6,128,661) (herein after Flanagin) and further in view of Atkinson (5,884,049).

As to claims 10 and 11, the argument above for claim 9 applies. However, Pipes and Flanagin do not explicitly disclose that the CPU is to operate at a higher frequency and a higher voltage when the device is docked than when undocked. Atkinson discloses that the processor is to operate at a higher frequency and a higher voltage when the device is docked (note the abstract and col. 1, lines 50-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a higher

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frequency and a higher voltage as taught by Atkinson in the system of Pipes and Flanagan since this will improve the processor performance.

As to claim 15, the argument above for claim 14 applies. However, Pipes and Flanagan do not explicitly teach that the CPU is to operate at a higher frequency and at a higher voltage when the CPU operates as a system CPU of the notebook computer than when the CPU operates as a system processor of the core computer. Atkinson discloses that the processor is to operate at a higher frequency and a higher voltage when the device is docked (note the abstract and col. 1, lines 50-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a higher frequency and a higher voltage as taught by Atkinson in the system of Pipes and Flanagan since this will improve the processor performance.

As to claim 20, the argument above for claim 17 applies. However, Pipes and Flanagan do not explicitly disclose operating the CPU at a higher frequency and voltage than when operating the CPU as a system CPU of the core computer. Atkinson teaches operating the CPU at a higher frequency and a higher voltage when the device is docked (note the abstract and col. 1, lines 50-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to operate the CPU at a higher frequency and voltage as taught by Atkinson in the system of Pipes and Flanagan since this will improve the processor performance.



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5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pipes (5,999,997) in view of Flanagin et al (6,128,661) (herein after Flanagin) as applied to claim 12 above, and further in view of Uehara et al. (5,754,798) (herein after Uehara).

As to claim 16, Pipes and Flanagin do not explicitly teach that the CPU is to operate in one of a high power mode and low power mode according to user preference. Uehara discloses a teaching that the processor can operate in different power mode set by the user (note col.16, lines 34-44). One ordinary skill in the art, at the time the invention was made, would have been motivated to employ different power mode for the processor as taught by Uehara in the system of Pipes and Flanagin because the user can save the power in lower mode. Otherwise, if the user needs a high CPU performance, he/she can choose the higher mode.

### ***Response to Arguments***

Applicant's arguments filed 07-27-2004 have been fully considered but they are not persuasive:

1. "Pipes, however, only teaches docking a portable computer into a server, rather than a notebook computer" (pages 7-8 of the Remarks), note at least col. 1, lines 49-51 where it said "the first computer may be a desktop computer, a desktop server or a portable computer".

2. "The principle operation of Pipes is to provide a server that is able to dock a portable computer, so that the server would not have to have peripherals such as a keyboard etc." (pages 8-9 of the Remarks):

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First, it is noted that Pipes discloses “*Among the advantages of the invention are one or more of the following. A dedicated keyboard, mouse or display **does not have to be purchased for the server**” (col. 2, lines 7-11) and “*file server 100 **does not typically require input/output(I/O) devices 230-23**”*, (Pipes does not state that computer 100 **does not have** keyboard, mouse, etc.), which means that computer 100 may have those I/O devices (even though they are not required), especially when computer 100 is a portable computer (col. 1, lines 49-51).*

Second, the Examiner does not see how this argument relates to claims 1, 12, and 17 since Pipes teaches computer 100 may be a desktop computer, a desktop server or a portable computer (col. 1, lines 49-51).

3. Therefore, to modify the server of Pipes to be a notebook computer, as claimed by applicant, would change the principle operation of Pipes... Although Pipes does fortuitously mention the conflicting statement that the first computer may be a portable computer... ” (page 9 of the Remarks), it is brought to Applicant’s attention again that the Examiner **does not modify** the server of Pipes to be a notebook computer, it is stated very clearly in Pipes that “the first computer may be a desktop computer, a desktop server or **a portable computer** (col. 1, lines 49-51), and it is also claimed in claim 15 “the first computer comprises a portable computer”.

### ***Conclusion***

This is a continuation of applicant's earlier Application No. 09/470,669. All claims are drawn to the same invention claimed in the earlier application and could have been finally

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rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

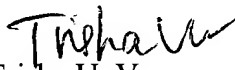
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trisha U. Vu whose telephone number is 703-305-5959. The examiner can normally be reached on Mon-Thur and alternate Fri from 7:00am to 4:30pm.

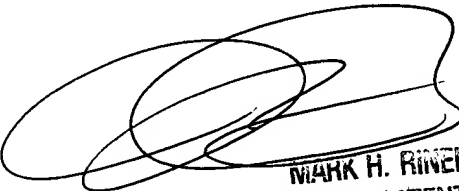
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703-305-4815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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Examiner  
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